

Appl. No. 10/617,458
Atty. Docket No. 6808D
Amdt. dated Nov. 10, 2005
Reply to Office Action of August 10, 2005
Customer No. 27752

REMARKS

Claim Status

Claims 1, 3, 4, and 6-23 are pending in the present application. No additional claims fee is believed to be due.

Claims 2, 5, and 16, are canceled without prejudice.

Claims 1 and 15 have been amended to more specifically characterized the present invention. Support for these amendments can be found in the specification, for example, in claims 2, 5, and 16, as filed. Support can also be found, for example, in the specification at page 9, lines 33-36 and page 10, lines 1-4. Claim 6 has been amended to more specifically characterize the present invention. Support for this amendment can be found in the specification, for example, on page 9, lines 18-31.

Claim 3 has been amended such that it now depends from claim 1. Support for the amendment can be found in the specification, for example, in claim 2. Claim 17 has been amended such that claim 17 depends from claim 15. Support for the amendment can be found in the specification, for example, at page 9, lines 18-21.

In addition, new Claims 21-23 have been added. Support for claims 21 and 22 can be found in the specification, for example, at page 9, lines 33-36 and page 10 lines 1-2. Support for claim 23 can be found in the specification, for example, at page 8, lines 1-2; page 10 lines 22-24; and page 12 lines 14-15.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Rejection Under Doctrine of Obviousness-type Double Patenting

The Office Action rejected Claims 1-20 under the judicially created doctrine of obviousness-type double patenting over commonly owned patent 5,914,084 issued Benson, et al. Applicants submit together with this reply a terminal disclaimer in compliance with 37 CFR 1.321(c). Accordingly, Applicant requests withdrawal of this rejection.

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Rejection Under 35 USC §102(b) Over Morman

Claims 1, 5-13, 15, 18, and 19, are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,226,992 issued to Morman, hereafter "Morman". Applicant respectfully traverses the rejection by the Office.

Case law provides that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Morman fails to teach all of the claim elements of amended claim 1 and also fails to teach all of the claim elements of amended claim 15. Therefore, Morman does not anticipate amended claim 1 or amended claim 15.

Morman teaches a method for creating "a composite elastic necked-bonded material including at least one necked material joined to at least one elastic sheet." (Abstract). Morman teaches that "the neckable material 12 passes through the nip 16 of the S-roll arrangement 18." (col. 5, lines 29-30). "From the S-roll arrangement 18, the neckable material 12 passes through the pressure nip 24 formed by a bonder roller arrangement 26." (col. 5, lines 32-34). Morman teaches that "[t]he bonder roller arrangement 26... may include a patterned calender roller." (col. 8, lines 30-33). However, Morman does not teach or suggest that the bonder roller arrangement includes the use of incremental stretching.

Because incremental stretching is a claim element in amended claim 1 and amended claim 15, Morman does not anticipate amended claim 1 and amended claim 15. Additionally, because claims 3, 4, 6-14, and 21-23, depend from amended claim 1, Morman also does not anticipate these claims. Similarly, because claims 17-20 depend from amended claim 15, Morman also does not anticipate these claims. Consequently, Applicant asserts that claims 3, 4, and 6-23, are patentable over Morman and are in condition for allowance.

Rejection Under 35 USC § 103(a) Over Morman in view of Sneed or in view of Sabee

Claims 1-20 stand rejected under 35 U.S.C. § 103(a) as being obvious over Morman in view of U.S. Patent No. 4,517,714 issued to Sneed et al., hereafter "Sneed", or in view of U.S. Patent No. 4,153,664 issued to Sabee, hereafter "Sabee". Applicant respectfully traverses the rejection by the Office Action.

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It is well settled that in order to establish a *prima facie* case of obviousness, three requirements must be met. MPEP §2143. First, there must be some suggestion or motivation, either in the cited references or in the knowledge generally available to one ordinarily skilled in the art, to modify the reference. *Id.* Second, there must be some reasonable expectation of success. *Id.* Third, the cited references must teach or suggest all of the claim limitations. *Id.* The Office Action has failed to establish a *prima facie* case of obviousness.

COMBINATION OF MORMAN AND SNEED:

First, there is no motivation to combine Morman and Sneed because the combination of Morman and Sneed teach away from the present invention. Amended claims 1 and 15 recite, in part, that the incremental stretching is provided in a direction which is not parallel to the width of the neckable material. The application also provides that the teeth and grooves of the incremental stretching rollers "may extend at an angle to the CD direction, but preferably not parallel to the MD or machine direction, as this type of incremental stretching would tend to expand the width of the web, thus defeating the purpose of the necking operation." (application specification page 10, lines 1-4). However, Sneed teaches a web which passes through incremental stretching rolls 24 and 25 which have teeth and grooves that are perpendicular to the axis of the rolls (parallel to the machine direction). (col. 3, lines 9-11). Thus, the if the method of Morman implemented the incremental stretching of Sneed, the width of the neckable material would expand. Consequently, the combination of Morman and Sneed teaches away from the invention of amended claim 1 and amended claim 15.

Second, there is no motivation to combine Morman and Sneed because the combination would contravene the purpose of Morman. As stated above, the application provides that incremental stretching parallel to the width of a necked material defeats the purpose of the necking operation. Because the incremental stretching of Sneed would induce stretching in a direction parallel to the width of the neckable material, the combination of Morman and Sneed would contravene the intended purpose of Morman, i.e. to provide "a composite elastic necked-bonded material including at least one necked material joined to at least one elastic sheet."

Third, assuming *arguendo* that there was motivation to combine Morman and Sneed, the Office Action still fails to establish a *prima facie* case of obviousness because the suggested combination does not teach or suggest all of the claim elements of amended

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claim 1 and amended claim 15. As stated previously, amended claims 1 and 15 recite, in part, that the incremental stretching is provided in a direction which is not parallel to the width of the neckable material. As stated above, the incremental stretching of Sneed would be parallel to the width of the neckable material of Morman. Consequently, the combination of Morman and Sneed do not teach or suggest incremental stretching in a direction which is not parallel to the width of the neckable material, which is a claim element of amended claim 1 and amended claim 15.

COMBINATION OF MORMAN AND SABEE:

First, there is also no motivation to combine Morman and Sabee because Morman teaches away from the present invention. The Office Action states:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the techniques of either one of Sabee or Sneed et al. (and provide the embossing rollers in Morman '992 with the specified configurations as identified by Sneed or Sabee) in the process of Morman '992 for treating a nonwoven web.

(Office Action page 5).

The combination suggested by the Office Action is understood to be providing the pattern of the incremental stretching rolls of Sabee to the bonder roller arrangement of Morman. It should be noted that Sabee states that "[e]mbossing webs using toothed rollers is not related to the invention described herein." (col. 1, lines 50-51). "Embossing constitutes compression deformation or crushing rather than tensile deformation." (col. 2, lines 51-52). Morman teaches that the "[t]he bonder roller arrangement 26... may include a patterned calender roller, such as, for example, a pin embossing roller arranged with a smooth anvil roller." (col. 8, lines 30-34). Because the bonder roller arrangement 26 of Morman can include a patterned calender roller, the pattern of Sabee on that patterned calender roller would still lead to embossing the web as opposed to incrementally stretching the web. Consequently, the suggested combination by the Office Action teaches away from the invention in amended claim 1 and amended claim 15 which recite, in part, that a neckable material is incrementally stretched.

Second, the suggested combination of Morman and Sabee do not teach or suggest all of the claim elements of amended claim 1 and amended claim 15. The method of amended claim 1 and amended claim 15 yield a stabilized extensible necked material which is a positive claim element of amended claim 1 and amended claim 15. The application states that "stabilized" refers to a material "which is capable of being stored in

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a stable condition in any common or conventional web storage manner without the need for further heating or the addition of or joinder with other webs to stabilize the material." (application specification page 3, lines 28-32).

In contrast, Morman teaches that the neckable material is necked and then joined to an elastic sheet. Because Morman does not teach or suggest that the necked material is incrementally stretched, it appears as though the elastic sheet, in part, stabilizes the necked material. Consequently, Morman does not teach a stabilized extensible necked material as is recited, in part, in amended claim 1 and amended claim 15. So regardless of the teachings of Sabee, incrementally stretching the material of Morman does not yield the stabilized necked material of the present invention. Consequently, the suggested combination of Morman and Sabee fails to teach or suggest all of the claim elements of amended claim 1 and amended claim 15.

For the foregoing reasons, Applicant asserts that claims 1 and 15 are nonobvious over the suggested combinations of Morman in view of Sneed and Morman in view of Sabee. Additionally, Applicant asserts that because claims 3, 4, 6-14, and 21-23, depend from amended claim 1 and because claims 17-20 depend from amended claim 15, that these claims are also nonobvious over the suggested combinations. Applicant therefore asserts that claims 1, 3, 4, and 6-23, are in condition for allowance.

Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 U.S.C. § 102(b) and § 103(a). Early and favorable action in the case is respectfully requested.

Respectfully submitted,

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By



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